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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/797,786 | 03/09/2004 | Takehiro Okanaka | KASAP049 | 5855 |

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EXAMINER

SCHWARTZ, CHRISTOPHER P

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3683

DATE MAILED: 11/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/797,786

Applicant(s)

OKANAKA ET AL.

Examiner

Christopher P. Schwartz

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WJ

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

CHRISTOPHER P. SCHWARTZ
PRIMARY EXAMINER

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement has been received and considered.

Drawings

2. The drawings are objected to because it appears from the discussion on pages 1 and 16 that figure 15 and possibly figures 13 and 14 should be labeled as "prior art". Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

3. The disclosure is objected to because of the following informalities: it is unclear what the purpose of the citations listed at the bottom of page 3 is..

Appropriate correction is required.

Claim Objections

4. Claims 1-12 objected to because of the following informalities: The claims contain numerous idiomatic errors throughout. They should be thoroughly reviewed and revised before preparing a response to this action. Appropriate correction is required.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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7. Claims 1-5,7-10,12 rejected under 35 U.S.C. 103(a) as being unpatentable over Bretaudeau et al. ('498).

Regarding claim 1 Bretaudeau et al. ('498) shows in figures 1-4 first and second mounting members 1,2, a generally tapered elastic body 3, functioning as claimed, a flexible layer in the area of numeral 4, a partition member, as claimed, at 5 dividing the fluid chamber therein into a pressure receiving chamber A and an equilibrium chamber B, an orifice passage 6, and a pair of restricting projections at 13,14 and/or elements 19 in figure 4.

'498 lacks showing the projections 13,14 or elements 19 being "bonded to" the partition member 5.

However as stated in column 5 lines 8-12 it is noted that the blades 18 can be integrally molded with the elastic body 3 along with filler weights 19. As shown in the drawings these filler weights appear to function as applicant's projections.

One having ordinary skill in the art at the time of the invention would have found it obvious to have "bonded" the elements 13,14 or 19 in the different embodiments either directly or indirectly (through the elastic element 3) to the partition member 5, to positively secure these elements within the mount or simply to limit fluid communication throughout portions of the mount dependent upon the damping characteristics desired. As broadly claimed elements 13,14,19 may all be considered to be "projections"

Regarding claims 2-3,5, for the reasons discussed above, '498 as modified meets the claimed requirements.

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Regarding claim 4, as broadly claimed, if elements 19 are considered to be the projections, as modified above, '498 meets the claimed requirements.

Regarding claim 7 the partition member 5 includes a through hole cover by a partition rubber plate 24,25, as shown. Although this element is not shown to be formed integral with the restricting projections 13,14 such a modification would be an obvious engineering design choice since it is well known to form plural parts integral and vice-versa for easier assembly, parts inventory, manufacturing costs etc. This modification could be made notwithstanding the discussion in column 4 lines 36 since it is made of a relatively soft material, as are the plate 25 and cone 3.

Regarding claim 8 note the abutting fins at 18 in the several embodiments of '498, at which point elements 19 may be interpreted as the projections. Applicants arrangement is merely an obvious alternative equivalent to that of '498. See the discussion on lines 8-12 of col. 5.

Regarding claim 9 the caulking arrangement (not labeled—but integral with 1) but to which the flexible layer is bonded is considered to be an obvious alternate equivalent arrangement to that of applicant's.

Regarding claim 10 to have modified the shape of the projections 13,14 or 18 would have simply amounted to an obvious alternative equivalent arrangement to that of '498 dependent upon the particular range of vibrations to be damped. Applicant lacks any criticality in the specification for these particular shapes and configurations.

Regarding claim 12, as discussed in column 5 lines 50-56, these requirements are met.

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8. Claim 6 rejected under 35 U.S.C. 103(a) as being unpatentable over '498 in view of Okanaka et al. '458..

Regarding claim 6 although '498 lacks a showing of a communication hole provided in the partition member 5 such an idea would have been obvious in view of the teachings of Okanaka et al. '458 dependent upon the desired vibrations to be damped through increased fluid communication between the chambers.

9. Claim 11 rejected under 35 U.S.C. 103(a) as being unpatentable over Bretaudeau et al. in view of Nanno or Ikeda.

Regarding claim 11 Bretaudeau et al. Lacks a showing the elastic body 3 having a varying thickness in the circumferential direction.

However the idea of varying the thickness of these members in such fluid filled mounts is old and well known in the art dependent upon the particular vibrations to be damped along a particular axis. Nanno or Ikeda are relied upon for a general teaching of the idea: See figures in both references.

To have varied the thickness of the elastic body of Bretaudeau et al., as taught by Nanno or Ikeda, would have been obvious for the reasons above.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references cited have been cited for showing related concepts to applicant's invention. These references should be carefully reviewed before preparing a response to this action..

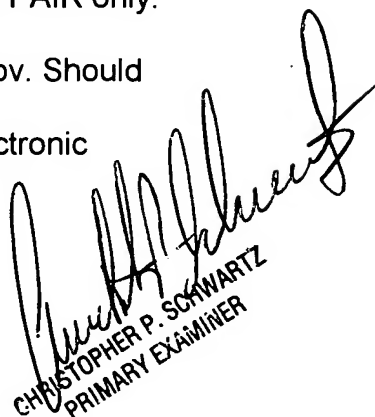
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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher P. Schwartz whose telephone number is 703-308-0576. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack W. Lavinder can be reached on 703-308-3421. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Cps
11/16/04


CHRISTOPHER P. SCHWARTZ
PRIMARY EXAMINER